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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,018	10/26/2006	Gregg D. Scheller	54084-62559	9316
21888 7590 07/14/2008 THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101			EXAMINER CHEN, VICTORIA W	
			ART UNIT 3739	PAPER NUMBER
			NOTIFICATION DATE 07/14/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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IPDOCKET@THOMPSONCOBURN.COM

Office Action Summary

Application No.

10/586,018

Applicant(s)

SCHELLER ET AL.

Examiner

VICTORIA W. CHEN

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9, 12 and 13 is/are rejected.
7) ☒ Claim(s) 2, 10, 11 and 14 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 1, 2 and 10-14 objected to because of the following informalities:

Claim 1, ll. 12-13 recites “a plurality of resilient arms that extend along the rod to distal ends of the arms”. This phrase is unclear because it is obvious that the arms would extend to their own distal ends, and the wording makes it very confusing. This same phrasing occurs in claim 2, ll. 23-25, claim 10, ll. 2-3 and claim 12, ll. 11-12.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by
Richards (US 5634918).**

Regarding claim 1, Richards discloses an elongate rod [14'] adapted to be attached to a surgical instrument head [col. 4, ll. 10-12], a piston [34'] mounted on the rod adjacent the rod distal end [Fig. 5], a forward grip member [22'] having a plurality of resilient arms [40'] that extend along the rod to operatively engage the piston [Fig. 5], whereby manual movement of the arm distal ends radially inwardly, moves the piston axially toward the rod distal end [Fig. 6], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 5]. If the first position is interpreted as seen in Fig. 6, and the second position is

interpreted as seen in Fig. 5, the second radial spacing between elements 40' is larger than the first radial spacing.

Regarding claim 8, Richards discloses an elongate rod [14'] adapted to be attached to a surgical instrument head [col. 4, ll. 10-12], a piston [34'] mounted on the rod adjacent the rod distal end [Fig. 5], a forward grip member [20H'] operatively connected to a plurality of resilient arms [40'] that extend along the rod to operatively engage the piston [Fig. 5], a ring [22'] mounted on the rod, engaged with the piston, whereby manual movement of the arm distal ends radially inwardly, moves the piston axially toward the rod distal end [Fig. 6], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 5]. If the first position is interpreted as seen in Fig. 6, and the second position is interpreted as seen in Fig. 5, the second radial spacing between elements 40' is larger than the first radial spacing.

Regarding claim 9, Richards discloses the ring [22'] has a sliding surface which the resilient arms [40'] engage [22N'], the resilient arms moving between the first radial spacing between the arms and the second radial spacing between the arms in response to the sliding movement of the arms on the ring sliding surface [Figs. 5 and 6].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-7, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards (US 5634918).

Regarding claim 3, Richards teaches an elongate rod [14'] adapted to be attached to a surgical instrument head [col. 4, ll. 10-12], a piston [34'] mounted on the rod adjacent the rod distal end [Fig. 5], a forward grip member [22'] having a plurality of resilient arms [40'] that extend along the rod to operatively engage the piston [Fig. 5], whereby manual movement of the arm distal ends radially inwardly, moves the piston axially toward the rod distal end [Fig. 6], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 5]. If the first position is interpreted as seen in Fig. 6, and the second position is interpreted as seen in Fig. 5, the second radial spacing between elements 40' is larger than the first radial spacing. However, Richards fails to teach the plurality of resilient arms being integral with the forward grip member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the resilient arms integral with the forward grip member, since it has been held that forming in one piece an article which has formerly been

formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Regarding claim 4, Richards teaches a connector [28] at the rod distal end that attaches the rod to a surgical instrument head [col. 4, ll. 10-12].

Regarding claim 5, Richards teaches the rod connector is adapted for removably attaching the surgical instrument heads [col. 8, ll. 56-57].

Regarding claim 6, Richards teaches the connector [28] has a center bore through it, and the piston [34] has proximal and distal ends, the piston distal end extending through the connector center bore [Fig. 4].

Regarding claim 7, since a slot is defined as “a narrow opening for receiving or admitting something”¹, the part of the lumen [labeled 30'] through near the distal end of rod [14] which is adjacent to the connector [28'] as seen in Fig. 5, is interpreted as the slot, while the piston proximal end [labeled at 34'] is positioned in the slot, and the piston distal end [labeled 34F'] is positioned in the connector bore [28'].

Regarding claim 12, Richards teaches the plurality of arms [40'] extending from the forward grip member [22'], the movement of the forward grip member relative to the rod [14] moving the distal ends of the arms relative to the rod [Figs. 5 and 6].

Regarding claim 13, Richards teaches the plurality of arms being circumferentially arranged around the rod and piston [Fig. 5].

Allowable Subject Matter

Claim 2 is allowed.

Claims 10-11 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

Applicant's arguments filed 4/7/08 with regards to claim objections regarding the resilient arms have been fully considered but they are not persuasive. Applicant argued that the current phrasing is necessary to positively recite the distal ends of the arms. However, the examiner still maintains that the wording of the claim is confusing since it is obvious that the arms would extend to their own distal ends. A clearer alternative phrasing such as, "the forward grip member having a plurality of resilient arms, each arm having a distal end which operatively engages the piston" is suggested.

Applicant's arguments filed 4/7/08 with regards to claim 1 have been fully considered but they are not persuasive. Regarding applicant's argument that the forward grip member [22'] disclosed by Richards does not include the resilient arms [40], there is no language in the claims which precludes the forward grip member and resilient arms being separate pieces of one component. The rejection is therefore upheld.

Applicant's arguments with respect to claim 3 have been considered but are moot in view of the new ground(s) of rejection. The new limitation has been addressed in the above rejections.

¹ slot." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 06 Dec. 2007. <Dictionary.com

Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection. A new interpretation of the ring and forward grip member is seen in the rejection above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victoria W Chen/
Examiner, Art Unit 3739

/Michael Peffley/
Primary Examiner, Art Unit 3739